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In re Application of	:	
TRIFONI, et al.	:	DECISION ON PETITION
Serial No.: 10/524,040	:	
PCT No.: PCT/EP03/09554	:	UNDER 37 CFR 1.47(a)
Int. Filing Date: 28 August 2003	:	
Priority Date: 28 August 2002	:	
Atty Docket No.: 267.187	:	
For: MEMBRANE ELECTROCHEMICAL	:	
GENERATOR	:	

This decision is issued in response to applicant's (third) "Renewed Petition under 37 CFR 1.47(a)" filed 30 March 2007 to accept the application without the signature of joint inventor, Eduardo Trifoni.

### **BACKGROUND**

The background for the present application was set forth in detail in the Decision on Petition mailed by this Office on 19 October 2006. In that Decision on Petition, applicant's renewed petition under 37 CFR 1.47(a) was dismissed without prejudice for failure to satisfy the requirements of a grantable petition.

On 27 October 2006, applicant filed the second renewed petition. In a decision on petition dated 23 March 2007, applicant's renewed petition under 37 CFR 1.47(a) was dismissed without prejudice for failure to satisfy the requirements of a grantable petition.

On 30 March 2007 applicant filed a "Renewed Petition under 37 CFR 1.47(a)." .

### **DISCUSSION**

A petition under 37 CFR 1.47(a) must be accompanied by (1) the fee under 37 CFR 1.17(g), (2) factual proof that the missing joint inventor refuses to execute the application or cannot be reached after diligent effort, (3) a statement of the last known address of the missing inventor, and (4) an oath or declaration by each 37 CFR 1.47(a) applicant on his or her own behalf and on behalf of the non-signing joint inventor. Items (1), (3) and (4) were previously satisfied.

Regarding item (2) above, petitioner states that Eduardo Trifoni has refused to sign the application. Section 409.03(d) of the MPEP, **Proof of Unavailability or Refusal**, states, in part:

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made. Statements by a party not present when an oral refusal is made will not be accepted.

Proof that a bona fide attempt was made to present a copy of the application papers (specification, including claims, drawings, and oath or declaration) to the nonsigning inventor for signature, but the inventor refused to accept delivery of the papers or expressly stated that the application papers should not be sent, may be sufficient. When there is an express oral refusal, that fact along with the time and place of the refusal must be stated in the statement of facts. When there is an express written refusal, a copy of the document evidencing that refusal must be made part of the statement of facts. The document may be redacted to remove material not related to the inventor's reasons for refusal.

When it is concluded by the 37 CFR 1.47 applicant that a nonsigning inventor's conduct constitutes a refusal, all facts upon which that conclusion is based should be stated in the statement of facts in support of the petition or directly in the petition. If there is documentary evidence to support facts alleged in the petition or in any statement of facts, such evidence should be submitted. Whenever a nonsigning inventor gives a reason for refusing to sign the application oath or declaration, that reason should be stated in the petition.

A review of the present petition reveals that applicant has not satisfied item (2) above, in that, the petitioner has not shown that a bona fide attempt was made to present the application papers, including the specification, claims, drawings, and oath/declaration to Eduardo Trifoni. Petitioner states that the "Attorney/Advisor has not properly considered the record since there are two declarations of Ms. Tuosto of record." Petitioner's assertion is incorrect, in that, both declarations (and accompanying exhibits) have been considered.

The declaration of Annie Tuosto dated 12 September 2005 states that Mr. Trifoni has refused to execute the application. However, Ms. Tuosto fails to include evidence that the application papers were received by the nonsigning inventor. Further, it is unclear from her declaration if a complete copy of the application was mailed to Mr. Trifoni. Moreover, no documentary evidence was included with the 12 September 2005 declaration.

Regarding the 30 May 2006 declaration, Ms. Tuosto fails to include evidence to demonstrate that the materials were received by the nonsigning inventor. Where the Office is being asked to accept the silence of the nonsigning inventor's as evidence of a refusal to sign, petitioner must provide some evidence that the application materials have been received by the nonsigning applicant.

As stated above, where a refusal of the inventor to sign the application papers is alleged, a statement of facts is needed from a person having first hand knowledge of the facts that a complete copy of the application papers (specification, claims, drawings and oath/declaration) were sent to Eduardo Trifoni, and when such papers were sent. In addition, copies of documentary evidence such as a certified mail return receipt, cover letter of instruction, telegrams, etc., should be supplied with the declaration. All documentary evidence should be translated into English.

In light of the above, it is not possible to grant applicant's petition at this time.

### **CONCLUSION**

For the reasons stated above, applicant's renewed petition under 37 CFR 1.47(a) is **DISMISSED**.

Any reconsideration on the merits of this petition must be filed within **TWO (2) MONTHS** from the mail date of this decision. Any reconsideration request should include a cover letter entitled "Renewed Petition Under 37 CFR 1.47(a)." Extensions of time may be obtained under 37 CFR 1.136(a).

Any further correspondence with respect to this matter should be directed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.



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